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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,097	12/27/2000	Hideki Toshikage	7254/63305	6249
530	7590	07/13/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/749,097	Applicant(s) TOSHIKAGE ET AL.	
	Examiner Mary Cheung	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 18-21 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 18-21 and 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This office action is in response to the amendment filed on April 25, 2006. Claims 1-4, 18-21 and 40-43 are pending. Claims 40-43 are added. Claims 1-4 and 18-21 are amended.

Response to Arguments

2. Applicant's arguments filed on April 25, 2006 have been fully considered but they are not persuasive.

The applicant's argues that the cited prior art fail to teach audio data is representative of a song and the photographic digital image data corresponds to the song. Examiner respectfully disagrees. Kagle (US 6,778,760) teaches recording the audio data and photographic data image using the recording device 100. The recording device 100 further comprises a synchronizer that synchronizes a particular photographic digital image with particular portion of the audio data (column 2 line 18 – column 3 line 37). As discussed in the office action below, Kagle does not specifically state that the audio data is a representative of a song; however, it would have been obvious to one of ordinary skill in the art to allow the audio data in Kagle's teaching to include songs for better utilize the usage environment of the digital recording device. Thus, the modified teaching of Kagle teaches to the audio data is representative of a song and the photographic digital image data corresponds to the song.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 18-21 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Kagle, U. S. Patent 6,778,760 and Garfinkle et al., U. S. Patent 6,017,187.

As to claim 1, Ginter teaches an image commercial transactions system comprising (Fig. 1):

- a) A reception dealer for accepting a sale of digital files comprising digital image with a handling condition associated with said digital image, for selling said digital files with said handling condition in a digital data format, and for transferring said digital files with said handling condition in said digital data format via an Internet line (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching, and the digital image is delivered in a restricted format at the consumer side according to the handling condition*);
- b) A charge accounting dealer for effecting an electronic charging an electronic accounting transaction for a purchase of said digital files with said handling condition in said digital data format, and accepting a request from a customer to

purchase said digital image (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

Ginter further teaches teach digital files include video, audio, images etc. (column 53 lines 59-60) with handling condition. Ginter does not specifically teach the digital files are audio data representative of a song and photographic digital image data. Kagle teaches transferring audio data associated with the photographic digital images, and the photographic images and said audio data being simultaneously played on a portable music player (column 2 lines 18-61 and Fig. 1). Kagle does not specifically state that the audio data is representative of a song. It would have been obvious to one of ordinary skill in the art to allow the audio data in Kagle's teaching to include songs for better utilize the usage environment of the digital recording device. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ginter's teaching to include the features of transferring audio data associated with the photographic digital images, and the photographic images and said audio data being simultaneously played on a portable music player as taught by the modified teaching of Kagle for enhancing Ginter's virtual distribution environment.

Ginter does not specifically teach the photographic digital image corresponds to an image associated with the song. However, Kagle teaches the photographic digital image corresponds to an image associated with the audio data (column 2 line 18 – column 3 line 67 and Fig. 1), and modified teaching of Kagle as discussed above teaches the audio data is representative of a song. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ginter's teaching

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to include the feature of the photographic digital image corresponds to an image associated with the song for enhancing Ginter's virtual distribution environment.

Ginter modified by Kagle does not specifically teach the photographic image data represent a thumbnail image. However, Garfinkle teaches displaying thumbnail images to a user (column 5 lines 10-29 and column 6 line 56 – column 7 line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the photographic image data in the teaching of Ginter modified by Kagle to be a thumbnail image so that the customer is able to quickly and easily view the image.

As to claim 2, Ginter modified by Kagle and Garfinkle teaches said reception dealer generate predetermined additional information for said photographic digital data image and said audio data, and distributes said generated additional information in a digital format (Ginter: column 54 lines 26-56; Kagle: column 2 lines 18-61 and Fig. 1).

As to claim 3, Ginter modified by Kagle further teaches said reception dealer distributes said additional information data comprising information as to a payment condition for purchasing said photographic digital image data and audio data, information as to a recorder's history of said photographic digital image data, text information data synthesized with said photographic digital image data (Ginter: column 24 lines 24-53 and column 54 lines 26-56 and column 317 lines 22-42 and column 320 lines 2-20; Kagle: column 2 lines 18-61 and Fig. 1).

As to claim 4, Ginter modified by Kagle teaches said reception dealer distributes said photographic digital image data and said audio data subjected to a scrambling process (Ginter: column 59 lines 48-54; Kagle: column 2 lines 18-61 and Fig. 1).

As to claim 18, Ginter teaches an image commercial transactions method comprising (Fig. 1):

- a) An image scanning step for converting a document into a digital image (column 299 lines 36-42);
- b) A publication step of enabling a reception dealer to produce image data pertaining to a plurality of digital images for sale and publicize said produced image data via an Internet line (column 7 lines 45-57);
- c) A reception step of enabling a reception dealer to accept a request for a sale of said digital image with a handling condition associated with to said digital image and to accept a selection of a receiver said from a plurality of receiver sides (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching*);
- d) A sale step of enabling said reception dealer to sell digital files with said handling condition in a digital data format (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and Figs. 1, 15A);
- e) A transferring step for transferring said digital files with said handling condition in said digital data format via said Internet line (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, this limitation corresponding to the digital image is delivered in a restricted format at the consumer side according to the handling condition in Ginter's teaching*);

f) A charge accounting step of enabling a charge accounting dealer for effecting an electronic charge accounting transaction for a purchase of said digital files with said handling condition in said digital data format (column 55 lines 44-60 and column 58 lines 3-63 and Figs. 1A, 3-4).

Ginter teaches the digital image being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanning step for converting a document into digital image as discussed above. Ginter does not explicitly teach the image scanning step is for converting a picture on a photographic film into a digital image. Garfinkle teaches an image scanning step for converting a picture on a photographic film into a digital image (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow the image scanning step in Ginter's teaching include the feature of converting a picture on a photographic film into a digital image because it would allow the picture related data to be better captured, efficiently stored, and later to be better distributed.

Ginter does not specifically teach a thumbnail image. However, Garfinkle teaches displaying thumbnail images to a user (column 5 lines 10-29 and column 6 line 56 – column 7 line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to Ginter to include the feature of a thumbnail image so that the customer is able to quickly and easily view the image.

Ginter further teaches teach digital files include video, audio, images etc. (column 53 lines 59-60) with handling condition. Ginter does not specifically teach the digital

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files are audio data representative of a song and photographic digital image data. Kagle teaches transferring audio data associated with the photographic digital images, and the photographic images and said audio data being simultaneously played on a portable music player (column 2 lines 18-61 and Fig. 1). Kagle does not specifically state that the audio data is representative of a song. It would have been obvious to one of ordinary skill in the art to allow the audio data in Kagle's teaching to include songs for better utilize the usage environment of the digital recording device. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ginter's teaching to include the features of transferring audio data associated with the photographic digital images, and the photographic images and said audio data being simultaneously played on a portable music player as taught by the modified teaching of Kagle for enhancing Ginter's virtual distribution environment.

Ginter does not specifically teach the photographic digital image corresponds to an image associated with the song. However, Kagle teaches the photographic digital image corresponds to an image associated with the audio data (column 2 line 18 – column 3 line 67 and Fig. 1), and modified teaching of Kagle as discussed above teaches the audio data is representative of a song. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ginter's teaching to include the feature of the photographic digital image corresponds to an image associated with the song for enhancing Ginter's virtual distribution environment.

Ginter modified by Garfinkle does not specifically teach handle an audio data associated with the digital image, said thumbnail image and said audio data being

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simultaneously played on a portable music player. This matter is taught by Kagle as simultaneously playing digital image with associated audio data on a portable music player (column 2 lines 18-61 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Ginter modified by Garfinkle to include the features of simultaneously playing digital image with associated audio data on a portable music player for enhancing Ginter's virtual distribution environment.

Ginter modified by Garfinkle and Kagle does not specifically teach the thumbnail image associated with the song. It would have been obvious to one of ordinary skill in the art to allow the thumbnail image in the teachings of Ginter modified by Garfinkle and Kagle to be associated with the song for allowing the user easy viewing the information as well as better promoting the sales of the digital files.

Claims 19-21 are rejected for the similar reasons as claims 2-4.

As to claims 40-41, the teachings of Ginter modified by Garfinkle and Kagle does not specifically teach the thumbnail image is an image of an album jacket associated with the song. It would have been obvious to one of ordinary skill in the art to allow the thumbnail image in the teachings of Ginter modified by Garfinkle and Kagle to be an image of an album jacket associated with the song for allowing the user easy viewing the information as well as better promoting the sales of the digital files.

As to claims 42-43, Ginter further teaches the handling condition includes duplicate limitation information (column 48 lines 18-33).

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final
Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

Mary Cheung
Primary Examiner
Art Unit 3621
July 6, 2006



**MARY D. CHEUNG
PRIMARY EXAMINER**